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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/536,762	03/28/2000	Akio Yamanishi	44319-051	5310
20277	7590	04/09/2004	EXAMINER	
MCDERMOTT WILL & EMERY 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			KREMER, MATTHEW J	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/536,762

Applicant(s)

YAMANISHI, AKIO

Examiner

Matthew J Kremer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

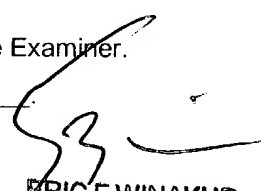
Claim(s) allowed: 3 and 21-26.

Claim(s) objected to: 2 and 11.

Claim(s) rejected: 4-10, 12 and 20.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
ERIC F. WINAKUR  
PRIMARY EXAMINER

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments filed 3/15/2004 have been fully considered but they are not persuasive. In regard to claim 20, U.S. Patent 5,770,454 to Essenpreis et al. teaches an apparatus for measuring bilirubin. (claim 4 of Essenpries et al.). Essenpries et al. teaches a light source. (column 8, lines 54-55 of Essenpries et al.). The light directed at the tissue has multiple wavelengths. (column 5, lines 50-52 of Essenpries et al.). The apparatus includes a light emerging port 17 and light incident ports 18 and 18'. (Fig. 2 of Essenpries et al.). Each light incident port reads in multiple wavelengths. (column 3, lines 62-67 of Essenpries et al.). There are two signal generators 48 and 48'. (column 10, lines 2-8 of Essenpries et al.). There is a calculator 49 and 50. (column 7, line 65 to column 8, line 29 of Essenpries et al.).

The Applicant contends that Essenpries et al. does not teach or suggest the elimination of the influence of skin by using the luminous fluxes of the different optical path lengths. Essenpries et al. teaches a calculator for calculating a bilirubin concentration from the signals received. (column 10, lines 2-8 and column 7, line 65 to column 8, line 29 of Essenpries et al.). The calculation concentrates on determining bilirubin but also eliminating other influencing factors, such as temperature. (column 4, lines 30-60 of Essenpries et al.). Essenpreis et al. teaches a processor that determines bilirubin using the four signals and excludes other influencing factors, i.e., the processor only concentrates on the calculation of the bilirubin concentration. The limitation "so that influence of skin is cancelled by using the luminous fluxes of the different optical

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path lengths" is merely "result" language and since the processor calculates bilirubin by using the four signals and accounts for influencing factors, the processor of Essenpreis et al. meets this limitation.

The Applicant also contends that "calculating bilirubin so that influence of skin is cancelled by the luminous fluxes" is not inherent in Essenpreis et al. The Applicant correctly asserts that an element/step must necessarily be present for an element/step to be inherent but the limitation "so that influence of skin is cancelled by using the luminous fluxes of the different optical path lengths" is merely a result and not an element or a step of the claimed invention. Because the limitation "so that influence of skin is cancelled by using the luminous fluxes of the different optical path lengths" is "result" language, it cannot be relied upon to define over Essenpreis et al. since Essenpreis et al. discloses all of the claimed elements and their recited relationships. See Ex parte Masham 2 USPQ 2<sup>nd</sup> 1647.

The Examiner would like to note that an additional structural limitation, such as "a calculator for calculating a bilirubin concentration based on the first to fourth electric signal that includes a processing unit that cancels the influence of skin by using the luminous fluxes of the different optical path length", would overcome the rejection in view of Essenpreis et al.